

## REMARKS

Upon entry of the amendments, claims 1, 3 and 5 will be pending in the application.

Applicant requests reconsideration of the Office Action based upon the following comments.

### *Claims Amendments*

Claim 1 has been amended to address the rejections and objection raised in the Office Action. For example, claim 1 incorporates features recited in former claim 4. Claim 1 recites (a) that the index sheet output control circuit causes the image output section to output an index sheet that carries index information, (b) that the index sheet output by the image output section under the control of the index sheet output control circuit is read by the image reading section, and (c) that the image data of the document read by the image reading section subsequently to the index sheet is stored in the storage area of the image storing section that is designated by a storage area designation information corresponding to the index information.

Claim 4 has been canceled.

Claim 5 has been added to the application and is based on the paragraph bridging pages 25 and 26 of the specification.

Applicant does not believe that any new matter has been introduced through these amendments and does not believe that any further claim fees are due.

### *Claim Objections*

Applicant has responded to the objection of claim 1 by correcting the grammatical error noted in the Office Action.

***Claim Rejections – 35 U.S.C. § 102***

Claims 1 and 4 are rejected under 35 U.S.C. §102(b) as being anticipated by Morisawa (US 5,881,214). Claim 4 was canceled so that rejection is believed to be moot.

Applicant has carefully considered the rejection of claim 1 and respectfully requests that it be withdrawn because Morisawa '214 fails to inherently or explicitly disclose all the features of the claimed invention.

According to amended claim 1, the image output section outputs an index sheet that carries index information from the index sheet output control circuit. This index information is established by the index sheet output control circuit. The index sheet can be used after it is output by the image output section under the control of the index sheet output control circuit. A user does not have to do anything extra like marking the index sheet before use. Thus, the user's operation is very simple.

Applicant notes that Morisawa '214 discloses an apparatus that prints index images registered in the apparatus on a mark sheet. On the mark sheet, a marking square 402 is provided adjacent to each of the index images 401. By properly marking the marking square 402, the index image adjacent to the making square 402 is designated. After marking the mark sheet, a user puts the mark sheet on the first page of document originals and sets the stack of mark sheet and the document originals on the image reading unit 25. This establishes a link between the marked index image and the read document originals in the apparatus.

Applicant asserts that the mark sheet of Morisawa '214 is not equivalent to the index sheet of the present invention because there is no correspondence between any of the index images and the storing area designating information without the user's marking operation on the

mark sheet. The arrangement of Morisawa '214 requires a more complicated operation than the present invention.

According to the present invention, a user can use index sheets as they are output by the apparatus to store image data of documents job by job, thereby realizing a very user-friendly image output apparatus.

Further, the mark sheet of Morisawa '214 has a one-to-one correspondence with the document, so that the mark sheet is for exclusive use for that document. Accordingly, if a user erroneously marks an unintended marking square or if a user erroneously attaches the mark sheet to an unintended document, then the user will experience problems in reproducing the document with the mark sheet.

According to the present invention, an index sheet and a document correspond to each other upon the reading operation. As such, there is no possibility of mistakenly corresponding an incorrect index sheet with a document.

### ***Claim Rejections – 35 U.S.C. § 103***

Claims 2 and 3 are rejected as obvious in view of Morisawa '214 and Morisawa '548. The Examiner acknowledges that Morisawa '214 fails to disclose a circuit for overwriting an index image output instruction accepting section, and index image output control circuit. The Examiner thus turns to Morisawa '548.

Applicant has also carefully considered this rejection and requests that it be withdrawn because the failings of Morisawa '214 (as discussed in regards of the anticipation rejection) are not alleviated upon consideration of Morisawa '548.

*New Claim*

Applicant believes that the cited patents fail to disclose or suggest the storing function based on the index information carried on an index sheet as recited in claim 5.

**CONCLUSION**

Applicant respectfully requests allowance of the application. If any additional fees are due in connection with the filing of this response, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

Date : June 23, 2004



Michael A. Makuch, Reg. No. 32,263  
1850 M Street, NW – Suite 800  
Washington, DC 20036  
Telephone : 202/263-4300  
Facsimile : 202/263-4329

SGRDC/217080.1